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Grace Bender

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EXAMINER

NGUYEN, HIEP VAN

ART UNIT

PAPER NUMBER

3626

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/812,936	BENDER, GRACE	
	<b>Examiner</b>	<b>Art Unit</b>	
	HIEP NGUYEN	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on April 20, 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/24/2007; 04/21/2005; 04/20/2004</u> .                      | 6) <input type="checkbox"/> Other: _____                          |



## DETAILED ACTION

### *Status*

1. Claims 1-54 have been examined.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9, 12-15, 20-23, 26, 35-39, 42-44, 46-47 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Barsky et al. (US 5,758,096.).

4. With respect to Claim 1, Barsky et al. teaches a method for managing the administration of multiple medications, the method comprising:

- a. gathering all medications to be administered ('096; col. 3, lines 60-66);
- b. ascribing a unique identifier to each separate medication ('096; Col. 4, lines 4-10);
- c. placing the ascribed unique identifier on a container associated with each separate medication ('096; Col. 4, lines 10-13; Fig 1: container [22] and unique identifier [25]);

- d. compiling on a first visual medium the time each medication is to be administered and associating the unique identifier with that time ('096; Fig 5A; Col. 6, lines 46-50);
  - e. recording on a second visual medium that the administration of each medication associated with the time for administration on the first visual medium has occurred ('096; Figs 5A and 6; medication list.)
5. With respect to Claim 2, Barsky et al. discloses further wherein the first and second visual mediums are charts ('096; Col. 6, lines 26-50.)
6. With respect to Claim 3, Barsky et al. further discloses wherein the first and second visual mediums are hard copies of charts ('096; Col/line 3/66-4/3.)
7. With respect to Claim 4, Barsky et al. discloses further comprising recording on the first visual medium the name of each medication to be taken and associating the name with the unique identifier and the time for administration ('096; Fig 2. letter code 32, time with letter code-breakfast, dinner...)
8. With respect to Claim 5, Barsky et al. discloses further comprising, for each identifier, recording on the first visual medium the purpose of the medication corresponding to each identifier ('096; Col. 5, lines 13-26.)

Claim 35 is rejected as the same reason with Claim 5.

9. With respect to Claim 6, Barsky et al. discloses further comprising, for each identifier, recording on the first visual medium the respective start and/or stop dates of the medication corresponding to each identifier ('096; Fig 6: stop date.)

Claim 36 is rejected as the same reason with Claim 6.

10. With respect to Claim 7, Barsky et al. discloses further comprising, for each identifier, recording on the first visual medium the dosage amount of the medication corresponding to each identifier that is to be taken at each administration ('096; Fig 2, Fig 5A:direction dosage; Col. 5, lines 13-26.)

Claim 37 is rejected as the same reason with Claim 7.

11. With respect to Claim 8, Barsky et al. discloses further comprising, for each identifier, recording on the first visual medium the strength of the medication corresponding to each identifier ('096; Figs 2, 5A strength; col. 4, lines 33-42.)

Claim 38 is rejected as the same reason with Claim 8.

12. With respect to Claim 9, Barsky et al. discloses further comprising, for each identifier, recording on the first visual medium directions and/or warnings associated with the medication corresponding to each identifier ('096; Fig5A direction and comments.)

Claim 39 is rejected as the same reason with Claim 9.

13. With respect to Claim 12, Barsky et al. disclose further wherein the placing of the unique identifier includes placing the unique identifier on a portion of the container indicating the name of the medication ('096; Col. 6, lines 20-33. )

14. With respect to Claim 13, Barsky et al. further discloses wherein the placing of the unique identifier includes placing the unique identifier on a side wall of the container ('096; Fig 1 container 22 with unique identifier 25.)

15. With respect to Claim 14, Barsky et al. further discloses wherein the placing of the unique identifier includes placing an adhesive label on each container ('096; Col. 7, lines 10-12.)

16. With respect to Claim 15, Barsky et al. further discloses wherein the placing of the unique identifier includes printing the identifier on each container ('096; Col. 6, lines 9-19.)

17. With respect to Claim 20, Barsky et al. teaches a system for managing the administration of multiple medications, the system comprising:

f. a source of a plurality of unique identifiers configured to be associated with each of a plurality of differing medications to be administered ('096; col. 3, lines 60-66; ; Col. 4, lines 4-10);

g. a first visual medium in hard copy form and containing indicia configured for recording the unique identifier associated with each medication and respective times of day for administering each of the plurality of medications ('096; Fig 5A; Col. 6, lines 46-50);

h. a second visual medium in hard copy form displaying each day the medications are to be administered and the respective times of day of administration, the second visual medium being configured to record confirmation that the medications recorded in the first visual medium were actually administered at the appropriate time ('096; Figs 5A and 6; medication list.)

Claim 52 is rejected as the same reason with Claim 20.



18. With respect to Claim 21, Barsky et al. teaches the system of claim 20, further comprising a third medium configured to place the unique identifiers on each of a plurality of containers containing each separate medication ('096; Col. 6, lines 9-12; lines 20-26.)

19. With respect to Claim 22, Barsky et al. teaches the system of claim 21, wherein the third medium comprises adhesive labels containing the unique identifiers for identifying each of the medications to be administered ('096; Col. 6, lines 23-26.)

20. With respect to Claim 23, Barsky et al. teaches the system of claim 22, wherein the identifiers comprise letters of the alphabet ('096; col. 6, lines 9-12.)

21. With respect to Claim 26, Barsky et al. teaches the system of claim 21, wherein the third medium comprises printed identifiers on each medication ('096; Col. 6, lines 20-26.)

22. With respect to Claims 42, 43 and 44, Barsky et al. further teaches comprising use instructions for directing users how to use the system, wherein the use instructions are in hard copy form, and comprising a sample visual medium of the first visual medium, wherein the sample visual medium contains sample information useful for

demonstrating how to record information in the first visual medium ('096; Fig 6 sample on hard copy.)

23. With respect to Claim 46, Barsky et al. further wherein the third visual medium includes at least one chart ('096; Fig 5A.)

24. With respect to Claim 47, Barsky et al. teaches the system of claim 45, wherein the third visual medium is in hard copy form ('096; Col. 6, lines 10-20.)

***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 10-11, 16-17, 18-19, 24-25, 40-41, 49, 51, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barsky et al. (US5,758,096) in view of Mayfield (US. 5,261,702.)

27. With respect to Claims 10 and Claim 11, Barsky et al. does not disclose further comprising, for each identifier, recording on the first visual medium a prescribing

physician of the medication corresponding to each identifier and comprising, for each identifier, recording on the first visual medium the specialty of the prescribing physician. However, Official notice is taken that including a prescribing physician and specialty to identifies the physician in healthcare has been known as a basis for the authorization of prescription.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Barsky et al. related to said physician's identification.

Claims 40 and 41 are rejected as the same reason with Claims 10 and 11.

28. With respect to Claims 16 and 17, Barsky et al. does not disclose further comprising sharing the information contained in the first visual medium and second visual medium with healthcare providers of the individual.

Mayfield et al. further discloses comprising sharing the information contained in the first visual medium and second visual medium with healthcare providers of the individual ('702, Col. 8, lines 37-45.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Mayfield related to sharing information with healthcare provider

29. With respect to Claims 18 and 19, Barsky et al. does not disclose wherein the sharing of the information includes sharing the information with the individual's pharmacists, physicians, and/or a hospital to which the individual is admitted the sharing of the information includes providing copies of the first and second visual mediums.

Mayfield further discloses wherein the sharing of the information includes sharing the information with the individual's pharmacists, physicians, and/or a hospital to which the individual is admitted the sharing of the information includes providing copies of the first and second visual mediums ('702; col. 8, lines 37-45.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Mayfield related to sharing information with healthcare professional.

30. With respect to Claims 24 and 25, Barsky et al. does not teach wherein the third medium comprises, for each letter of the alphabet, twelve adhesive labels containing the respective letter of the alphabet, and wherein the third medium further comprises a plurality of blank adhesive labels.

However, this is representative of non-functional descriptive material as each letter of alphabets is not functionally related to a system. And it has been held that nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious (*In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir.1983))

31. With respect to Claims 49 and 51, Barsky et al. does not teaches wherein the third visual medium includes a chart and wherein the card is approximately pocket-sized.

Mayfield further discloses wherein the third visual medium includes a chart and wherein the card is approximately pocket-sized ('702; Col. 8, lines 3-7.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Mayfield related to sharing information with healthcare professional.

32. With respect to Claim 54, Barsky et al. does not disclose comprising a means for providing use instructions for using the system.

Mayfield further discloses comprising a means for providing use instructions for using the system ('702; Col. 8, lines 40- 45.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Mayfield related to sharing information with healthcare professional.

33. Claims 27-34, 45, 48, 50, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barsky et al. (US5,758,096) in view of Donnelly et al. (US. 5,123,676)

34. With respect to Claim 27, Barsky does not disclose further comprising a folder. However, Donnelly et al. discloses further comprising a folder ('676; Abstract.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Donnelly et al. related to a folder system for storing prescription forms.

35. With respect to Claim 28, the combined art does not disclose comprising a folder configured to hold the labels, the first visual medium and the second visual medium.

However, official notice is taken that including said labels, said first and second visual medium storing in the folder has been known as a basis for the storage of medical records.

36. With respect to Claims 29 and 30, Barsky does not disclose further comprising a notebook configured to hold the labels, the first visual medium, and the second visual medium and wherein the notebook is a spiral bound notebook.

Donnelly et al. further discloses comprising a notebook configured to hold the labels, the first visual medium, and the second visual medium and wherein the notebook is a spiral bound notebook ('676; Abstract: file guide book, Figs. 1B, 2 spiral book.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Donnelly et al. related to a folder system for storing prescription forms.

37. With respect to Claim 31, Barsky does not disclose wherein the notebook is an adhesive bound notebook.

Donnelly et al. further discloses wherein the notebook is an adhesive bound notebook ('676; Col. 11, lines 20- 30.).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Donnelly et al. related to a folder system for storing prescription forms.

38. With respect to Claims 32 and 33, Barsky does not disclose wherein the labels, the first visual medium, and the second visual medium are removable from the notebook and wherein the labels, the first visual medium, and the second visual medium are perforated so as to permit removal from the notebook.

Donnelly et al. further disclose wherein the labels, the first visual medium, and the second visual medium are removable from the notebook and wherein the labels, the first visual medium, and the second visual medium are perforated so as to permit removal from the notebook ('676; Abstract.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Donnelly et al. related to a folder system for storing prescription forms.

39. With respect to Claim 34, Barsky does not disclose wherein the notebook comprises dividers for separating the labels, the first visual medium, and the second visual medium.

Donnelly et al. further discloses wherein the notebook comprises dividers for separating the labels, the first visual medium, and the second visual medium ('676; Col. 6, lines 25-55.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Donnelly et al. related to a folder system for storing prescription forms.

40. With respect to Claim 45, Barsky does not disclose comprising a third visual medium containing indicia configured for recording healthcare and/or emergency contact information. Donnelly et al. further discloses comprising a third visual medium containing indicia configured for recording healthcare and/or emergency contact information ('676; Fig 3, item 52, medical records 42.)



Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Donnelly et al. related to a folder system for storing contact information.

41. With respect to Claim 48, Barsky et al. does not disclose comprising a third visual medium containing indicia configured for recording scheduled medical appointments. Donnelly et al. further discloses comprising a third visual medium containing indicia configured for recording scheduled medical appointments ('676; fig 2- special date).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Donnelly et al. related to medical appointments in said folder system.

42. With respect to Claim 50, Barsky et al. does not disclose comprising a card containing indicia configured to record vital information regarding an individual's healthcare. Donnelly et al. further disclose comprising a card containing indicia configured to record vital information regarding an individual's healthcare ('676; Fig 2, vital records.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Donnelly et al. related to vital records in said folder system.

43. With respect to Claim 53, Barsky does not teach comprising a fourth means for storing the first means, the second means, and the third means. Donnelly et al. further discloses comprising a fourth means for storing the first means, the second means, and the third means ('702; Abstract-file folder system.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Barsky et al. and Donnelly et al. related to a folder system for storing prescription forms.

### ***Conclusion***

44. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEP NGUYEN whose telephone number is (571) 270-5211. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

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